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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,509	04/28/2005	Duncan Alexander Robertson	MCI-7307	4045
26294 7590 06/16/2010 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVELAND, OH 44114				
EXAMINER				
MEHTA, PARIKHA SOLANKI				
ART UNIT		PAPER NUMBER		
3737				
MAIL DATE		DELIVERY MODE		
06/16/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/509,509

Applicant(s)

ROBERTSON ET AL.

Examiner

PARIKHA S. MEHTA

Art Unit

3737

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-23.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/BRIAN CASLER/
Supervisory Patent Examiner, Art Unit 3737

Continuation of 3. NOTE: The amendment to claim 9 changes the scope of the claimed invention to the extent that new search and consideration would be required before a determination of patentability could be made.

The proposed amendments would be effective to overcome the previous rejection of claims 1-22 as omitting essential elements and the rejection of claim 9 as being indefinite.

As prosecution on the merits is closed, the Examiner will only briefly address the arguments submitted by Applicant after the Final Rejection.

Regarding claims 4 and 6, Examiner suggests amending the claims to recite "wherein the collected radiation has a Gaussian [or Bessel] profile" in order to correct the antecedent basis deficiency.

Regarding the rejection of claims 10-12 and 22 under 35 U.S.C. 112, second paragraph, Examiner respectfully directs Applicant's attention to MPEP 2181, which clearly explains that the phrase "means for" cannot be modified by sufficient structure. As claim 10 further limits the means for scanning as comprising a deflector, such a claim is in violation of the requirement for properly invoking 112, 6th paragraph.

Regarding Applicant's challenge of the Examiner's interpretation of "defined", the Examiner maintains that a radiation beam inherently has some predetermined profile; i.e. it is "a prior known" that the beam has a sensitivity profile.

Regarding Applicant's challenge of the Examiner's interpretation of "focusing" as constituting the claimed "isolation", the definition of "isolating" as set forth by Merriam Webster is "to set apart from others". Accordingly, the concentration of the beam by a focusing element onto a point reasonably constitutes setting the beam apart from other possible radiation at that point, and the reference meets the claim. The specification sets forth the recited means for isolating as "isolator 28 can take any suitable form" (paragraph 43). On a related note, "for preventing signal leakage" does not structurally limit the claimed isolator.

Regarding Applicant's argument that Edrich fails to disclose the rotation of the reflector, Examiner notes that the rejection is predatory on the recitation of "operable"; in other words, the reference need not explicitly state that the reflector is rotatable, so long as it can reasonably be understood that such rotation would be possible, which Examiner maintains. Such explanation was similarly stated in the previous rejection, and it adequately addresses Applicant's previous arguments regarding claim 10.

Regarding the recited limitation of the beam profile being symmetrical and reduced about a spot along the collection path, Examiner maintains such feature is typical of the Gaussian beam taught by the prior art.

Regarding the obviousness of ranges, the difference in scope of the prior art and recited ranges does not preclude a rejection of obviousness, and the specification fails to explicitly show the novelty of the specific range recited by the claims.

Regarding Applicant's arguments directed towards the consideration of functional language, where it is unsupported by structure to explicitly produce such function, the recitation is not given significant patentable weight.

Regarding the interpretation of calibration, the removal of noise as taught by the prior art constitutes "adjusting by comparison with a standard the accuracy of a measuring instrument" as argued by the Applicant.

Regarding the purported lack of articulated reasoning to show motivation to combine the references cited in the previous rejection, Applicant's attention is directed towards section 7 of the rejection, which states the combination to be motivated by the desire to "better control the direction of radiation towards the imaging plane".

Regarding the recitation of scanning in a collection path that forms a notional cylinder, "rotating along a central axis" as claimed and argued by Applicant is met by the prior art in view of the definition of "along" as meaning "in agreement with" or "in the course of" (Merriam Webster).